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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Muncharu Itoh

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EXAMINER

NOTE, JANIS L

ART UNIT

PAPER NUMBER

1756

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/721,069

Applicant(s)

ITOH, MUNEHARU

Examiner

Janis L. Dote

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1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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1. The examiner acknowledges the amendment to claim 1 filed on Nov. 21, 2006. Claims 1-3, 5, and 6 are pending.

2. The objection to the specification set forth in the office action mailed on Aug. 28, 2006, paragraph 5, has been withdrawn in response to amended paragraph [0064] in the specification filed on Nov. 21, 2006.

The prior art rejections of claims 1-3, 5, and 6 under 35 U.S.C. 103(a), set forth in the office action mailed on Aug. 28, 2006, paragraphs 8-12, have been withdrawn in response to the amendment to claim 1 filed on Nov. 21, 2006. That amendment to claim 1 added the limitation that the external additive comprises (A) calcium phosphate particles or calcium carbonate particles having a volume average primary particle diameter of 0.1 to 3.0 μm , (B) silica particles having a volume average primary particle diameter of 5 to 18 nm, and (C) silica particles having a volume average primary particle diameter of 20 to 60 nm. None of the cited references teaches or suggests a toner comprising the external additive as now recited in instant claim 1, and the limitation that "the average number of particles of the external additive, having a particle diameter in the range of 0.1 to 3.0 μm , on the surface of the colored

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polymer particle, is in the range of 10-500 particles per single colored polymer particle" recited in instant claim 1.

3. The examiner notes that the instant specification determines the "average circle degree" recited in the instant claims by the formula disclosed at page 10, paragraphs 0025-0026. The specification further discloses in paragraph 0026 that the average circle degree may be measured with "flow type particle projection image analyzers, such as FPIA-1000 or FPIA-2000, products of Sysmex Corporation."

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-3, 5, and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

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inventors, at the time the application was filed, had possession of the invention now claimed.

Instant claim 1 recites that the colored polymer particle is "produced by polymerization reaction."

The originally filed specification does not provide an adequate written description of said colored polymer particle as recited in instant claim 1. Applicant asserts that a "colored polymer particle produced by a polymerization reaction" is supported in paragraphs [0020] to [0022] of the specification. However, the originally filed specification in paragraphs [0020] and [0021] merely describes core-shell colored polymer particles. The originally filed specification in paragraph [0022] describes the use of the "amount of polymerizable monomer used for polymerization of shell layer" to determine the thickness of the shell. The limitation that "colored polymer particle is produced by polymerization reaction" recited in instant claim 1 is broader than the disclosed polymerized shell layer because it also encompasses core particles formed by a polymerization reaction, which are not described in paragraph [0022].

6. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject

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matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 3, which depends from independent claim 1, recites that the colored polymer particle has "a core-shell structure." However, claim 1 already requires that the "colored polymer particle . . . has a core-shell structure."

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
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JLD

Feb. 2, 2007